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**AVERP2168USA**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Bernard S. Mientus et al.

Serial No: 09/332,273

Filed: June 11, 1999

Art Unit: 1762

Examiner: E. Tsoy

For: MULTILAYERED THERMOPLASTIC FILM AND SIGN CUTTING  
METHOD USING THE SAME

REPLY UNDER RULE 1.116

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This letter is in response to the Communication mailed from the Patent Office on August 27, 2003. Claims 81-85, 87-89, 91-95, 97-99, 101-104, 107-110, 113 and 115-118 are pending in the application. All of these claims have been rejected, and the rejection has been made final. The Examiner is requested to reconsider the rejection of the claims and to allow all of the claims which are pending in the application.

Claims 81-85, 87, 91-95, 97, 101-104, 107, 108 and 113 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller (US 4,532,189) in view of EP 569878, and further in view of Josephy et al. (US 5,451,283).

Claims 88, 89, 98, 99, 109 and 110 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller (US 4,532,189) in view of EP 569878 and Josephy et al. (US 5,451,283) and further in view of Schreck et al. (US 5,716,698).

Claims 115-118 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller (US 4,532,189) in view of Josephy et al. (US 5,451,283) for the reasons or record as set forth in Paragraph No. 6 of the Office Action mailed on July 11, 2003.

With regard to the first rejection, these claims have been rejected over the noted references for the reasons as set forth in Paragraph Nos. 4 and 5 of the Office Action mailed on July 11, 2003 (Paper No. 22) since the limitations of former claims 86 and 96 have been inserted into claims 81 and 93. The Examiner has further indicated on Page 4 of the Final Rejection, in response to Applicant's arguments,

Mueller does suggest the desirability to include a layer of sealable material to at least one side of his multilayer film (of olefin/EVA blend) by teaching "The multi-layer film may be combined with other polymeric materials for specific applications. For instance, relatively thin layers may be added on either or both sides of the basic preferred three layer structure to improve seal strength or to lower gas and moisture permeability" (see column 4, lines 35-50).

Based upon his teaching in Mueller, the Examiner has concluded that "one of ordinary skill in the art would be motivated to use olefins/EVA multi-layer films of Mueller for making flexible labels according to teaching of Josephy et al. with the expectation of providing the labels with desired improved physical characteristics. One of ordinary skill in the art would have a reasonable expectation of success since labels of Josephy et al. are also made of olefin/EVA multi-layer films.

Reconsideration is requested. Although Mueller suggests "the desirability of modification for specific applications, the application he illustrates are those relating to shrinkable films. Further, there is absolutely no suggestion in Mueller that his multi-layer films may be combined with other polymeric materials for applications such as labels and signs. The Examiner's extension of the term "specific applications" to include any application such as a label or sign is unwarranted and unsupported. In fact, Mueller issues his own caution in column 7, lines 12-18:

Additional layers and/or minor amounts of additives of the types described above may be added to either the 3-layer or 5-layer structure of the present invention as desired but care must be taken not to adversely alter the desirable shrink tensions, shrink properties, optics and other characteristics of the multi-layer film of the present invention.

In view these cautions listed by Mueller, it is respectfully submitted Mueller's "specific applications" related to applications as shrinkable films only, and it would not be obvious to one skilled in the art to add a pressure sensitive adhesive layer to the multi-layer films described by Mueller for the purpose of preparing film for signs and labels.

In the previous response filed by Applicants on July 30, 2003, Applicants submitted that it would not be obvious to combine the teachings of Mueller and Josephy et al. since the two patents are directed to different technologies. That is, Mueller is directed to shrink films that are useful in packaging (column 1, line 9) whereas Josephy et al. '283 is concerned with oriented and annealed films which are not shrinkable and are useful in label manufacture.

On Page 5 of the Final Rejection, the Examiner stated

Films of Mueller may be oriented by stretching (see column 7, lines 23-25); and films of Josephy et al. may also be oriented by stretching (see column 8, lines 31-39). One of ordinary skill in the art at knows that multilayer polymeric films are used for making packaging materials as well as label materials.

Although the films of Mueller and the films of Josephy et al. both may be oriented by stretching, Josephy et al.'s films are further annealed after stretching so that such films are not shrinkable. Mueller's films are oriented by stretching but are not annealed and, therefore, are shrinkable. Accordingly, Applicant again repeats that the Mueller and Josephy et al. references are not combinable because they are directed to different technology.

With regard to claims 103-104, 107-110, 113 and 115-118, which are directed to "unoriented films", Applicants submit that these claims contain an additional distinction over Mueller which renders these claims unobvious and therefore patentable over the combination of the references cited by the Examiner. In order to produce shrinkable films, Mueller's films are stretched to biaxially orient the films. See, for example, column 7, lines 23-24; column 8, lines 21-23 and 29-35; and Examples I-III in column 8-10. The films prepared in Examples I-III are indicated in Table I (column 11) as having a free shrink in a machine direction and in a cross direction.

There is no teaching or suggestion in Mueller that would motivate one skilled in the art to substitute an unoriented film for the oriented heat shrinkable film described by Mueller. It is respectfully submitted that the Examiner's reliance on Josephy et al. is an example of hindsight reasoning resulting from a reading of Applicant's specification. It is well established that even though the prior art can be modified, the prior art must have made some suggestion of the modification. . In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

### **CONCLUSION**

For the reasons given above and those presented in the Amendment filed in the Patent Office on July 30, 2003, Applicants respectfully submit that all of the claims pending in the application are patentable over the references relied upon by the Examiner. The early action allowing the claims is solicited.

Respectfully submitted,

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